UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,622	07/05/2007	Lorrene Bayon	979-253	3107

39600 7590 05/07/2009

SOFER & HAROUN LLP.
317 MADISON AVENUE, SUITE 910
NEW YORK, NY 10017

EXAMINER	
MOORE, MARGARET G	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
05/07/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/591,622	BAYON ET AL.	
	Examiner	Art Unit	
	Margaret G. Moore	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 to 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 to 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/5/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Applicant's election without traverse of the zinc oxide filler containing lead oxide, that is doped and contains both a linear and insulating filler in the reply filed on 1/16/09 is acknowledged.

2. Claims 1 to 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear from the language in the claims if the zinc oxide and at least one metal oxide as traces are present in the same powder (i.e. there is only one type of filler) or are present in separate powders (i.e. there is a combination of different fillers). Clarification is required.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1 to 3, 5 to 7, 9, 12 to 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp et al.

Kemp et al. teach an electrical stress control composition containing a polymeric matrix filled with doped zinc oxide varistor powder. As can be seen from column 4, lines 66 and on, the powder contains at least 85 wt% zinc oxide, preferably at least 90 wt%. The top of column 7 teaches various metal oxides that can be present in addition to zinc oxide. Since the range "at least 90 wt%" embraces the range of claim 1 of at least 97 wt%, one having ordinary skill in the art would have found such a claimed range to have been obvious. Please note that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation). In this manner, the instant claims are rendered obvious.

For claims 3 and 18, please see column 4 line 49, which teaches a particle size range from 5 to 100, preferably of 25 to 75 micron, which embraces and renders obvious the claimed range of less than 50 micron and less than 10 micron.

For claims 5 and 6 please see the top of column 5 which suggests trace amounts of boron.

For claims 7 and 9, please see column 5, lines 15 and on, which teaches the addition of known additives to improve processability of the polymeric material. Though this does not explicitly teach linear or insulating fillers, the addition of such fillers are extremely common in the polymer field such that one having ordinary skill in the art would have found the addition of such fillers obvious. Please note that it is prima facie obvious to add a known ingredient to a known composition for its known function.

For claims 12 and 20, please see column 5, lines 33 and on.

For claims 13 to 18, please note that the composition therein is used for cable joints and terminations (see abstract).

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp et al as applied to claim 1 above, and further in view of Gupta et al.

While Kemp et al. teach the addition of dopants that are known in the art of doped zinc oxide varistor materials, they do not specifically teach lead oxide.

Gupta et al. teach doped zinc oxide varistor materials. Column 1, lines 61 and on, teach various metal oxides that can be present in the zinc oxide varistor, including many of those found in Kemp as well as lead oxide. This indicates the functional equivalent and alternative use of such metal oxides in zinc oxide varistors.

Thus one having ordinary skill in the art would have been motivated by the teachings in Gupta et al. to use lead oxide as a dopant for the material in Kemp et al. with a reasonable expectation of obtaining equivalent, predictable and useful results. In this manner claim 4 is rendered obvious.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-

272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796
mgm
5/6/09